

REMARKS

The Official Action mailed July 21, 2003, has been received and its contents carefully noted. Filed concurrently herewith is a *Request for Two Month Extension of Time*, which extends the shortened statutory period for response to December 21, 2003. Accordingly, the Applicants respectfully submit that this response is being timely filed.

The Applicants note with appreciation the consideration of the Information Disclosure Statement filed on September 20, 2002. However, the Applicants have not received acknowledgment of the IDS's filed on November 2, 2001 (received by OIPE on January 16, 2002), November 30, 2001 (received by OIPE on January 4, 2002), and May 9, 2003. Although the Applicants received a copy of the IDS filed November 2, 2001, the IDS was not considered by the Examiner. Also, the Applicants note the partial consideration of the IDS filed on April 18, 2002. Specifically, it appears that the Examiner inadvertently overlooked the citation of U.S. Patent No. 5,340,999 to Takeda et al. It is respectfully submitted that all of the above-referenced IDS's fully comply with 37 CFR § 1.98. The Applicants respectfully request that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of the above-referenced IDS's.

Claims 1-23 are pending in the present application, of which claims 1-11 are independent. Claims 1, 3 and 5 have been withdrawn from consideration. Claims 2, 4 and 6-23 are currently elected, of which claims 2, 4 and 6-11 are independent, and claims 2 and 8 are generic. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

In response to the request in the Official Action, the abstract has been amended to correspond with the claims of the present application.

The Official Action rejects claims 2, 4 and 6-23 as obvious based on the combination of U.S. Patent No. 5,003,356 to Wakai et al., U.S. Patent No. 5,358,810 to Yoshino, U.S. Patent No. 5,042,920 to Yoshino et al., and the Bahadur article, "Liquid Crystal Devices and Uses," Vol. 1, World Scientific Press 1990, pages 178-181 and

421-423. The Applicants respectfully traverse the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Also, MPEP § 2142 states that the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. It is respectfully submitted that the Official Action has failed to carry this burden. While the Official Action relies on various teachings of the cited prior art to disclose aspects of the claimed invention and asserts that these aspects could be used together, it is submitted that the Official Action does not adequately set forth why one of skill in the art would combine the references to achieve the present invention.

The Applicants respectfully submit that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art, to modify Wakai, Yoshino '810, Yoshino '920 and Bahadur or to combine reference teachings to achieve the claimed invention.

Wakai appears to teach a first insulating film 108a formed over a thin film transistor (Fig. 7). Wakai also teaches a pixel electrode 110, and an opposite transparent substrate 116 having a transparent electrode 115 (Fig. 5). Yoshino '810 appears to teach color filters 18, with overcoating layer 28, and light shielding films 24 and 25. Yoshino '920 appears to teach features similar to Yoshino '810, that is colored layers 4 with overcoat 3 and light shielding film 14. Bahadur is relied upon to teach dyed type black matrix.

The Official Action concedes that Wakai does not teach "any reference to the color filter and black matrix on the opposite substrate between the electrode and substrate" (page 4, Paper No. 6). The Applicants further submit that Wakai does not teach or suggest a leveling film formed over color filters and/or black stripes formed over a second substrate which is opposite a first substrate over which a TFT and a pixel electrode are formed. The Official Action relies on Yoshino '810, Yoshino '920 and Bahadur to allegedly teach the features missing from Wakai. The Official Action asserts that it would have been obvious to one of ordinary skill to employ a color filter substrate of either Yoshino reference in the device of Wakai (Id.). The Applicants respectfully disagree.

There is no teaching in the prior art of record to suggest how or why one of ordinary skill in the art one would modify Wakai in view of Yoshino '810, Yoshino '920 and Bahadur. Specifically, it is not taught or suggested how or why one of ordinary skill in the art would incorporate color filters 18, overcoating layer 28, and light shielding films 24 and 25 of Yoshino '810 with the opposite transparent substrate 116 and transparent electrode 115 of Wakai. In other words, why would one rip off the top portion of the device shown in Fig. 1 of Yoshino '810 and substitute it for or adapt it to the substrate 116 and electrode 115 of Fig. 5 of Wakai? Similarly, it is not taught or suggested how or why one of ordinary skill in the art would incorporate colored layers 4,

overcoat 3 and light shielding film 14 of Yoshino '920 to the opposite transparent substrate 116 and transparent electrode 115 of Wakai.

Further, with respect to independent claims 2, 4 and 6, the prior art of record does not recognize the advantage first recognized by the present Applicants of a combination of a first leveling film over a TFT and first substrate and a second leveling film over color filters and/or black stripes formed over a second substrate. The thickness of a liquid crystal layer can be made more uniform by utilizing leveling films over both substrates.

The Official Action argues that it would have been obvious to combine the devices of Wakai and Yoshino since the Yoshino device is "easily formed" (Id.). However, just because one feature of Yoshino is "easily formed" does not teach or suggest that Wakai should be completely redesigned so as to include the easily formed feature of Yoshino. Yoshino appears to simply suggest practicing Yoshino alone, and not in combination with a second device.

Even assuming motivation could be found, the Official Action has not given any indication that one with ordinary skill in the art at the time of the invention would have had a reasonable expectation of success when combining Wakai, Yoshino '810, Yoshino '920 and Bahadur.

The Applicants further contend that even assuming, *arguendo*, that the combination of Wakai, Yoshino '810, Yoshino '920 and Bahadur is proper, there is a lack of suggestion as to why a skilled artisan would use the proposed modifications to achieve the unobvious advantages first recognized by the Applicants. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.


In the present application, it is respectfully submitted that the prior art of record, alone or in combination, does not expressly or impliedly suggest the claimed invention and the Official Action has not presented a convincing line of reasoning as to why the

artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

For the reasons stated above, the Official Action has not formed a proper *prima facie* case of obviousness. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,



Eric J. Robinson
Reg. No. 38,285

Robinson Intellectual Property Law Office, P.C.
PMB 955
21010 Southbank Street
Potomac Falls, Virginia 20165
(571) 434-6789